

R E M A R K S

Claims 91-123 are currently pending. As will be discussed in further detail below, claims 91, 110, 119 and 122 have been amended to more distinctly claim that which Applicants regard as their invention.

As will also be discussed in further detail below, the specification has been amended to correct recitation of priority, to recite SEQ ID NOs., update the status of pending applications cited in the instant application and correct editorial errors that have heretofore gone unnoticed. No new matter has been added. The Abstract has been amended as well.

1. Information Disclosure Statement

The examiner notes that applicant does not provide legible copies for JP 146299 and Promega catalog, page 150, Figure 4G in the information disclosure statement filed on December 10, 2003, these references have not been considered in Form PTO-1449 filed on December 10, 2003 (see attached the Form PTO-1449).

In response, JP 146299 and the Promega catalog page will be submitted under separate cover in a Supplemental Information Disclosure Statement.

2. Oath/Declaration

It is noted that the oath or declaration is defective. The Office Action states that a new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. It is asserted that the oath or declaration is defective because the inventor, Dean L. Engelhardt did not date the oath/declaration.

In response, Applicants note that MPEP 602.05 now states the following:

The Office no longer checks the date of execution of the oath or declaration and the Office will no longer require a newly executed oath or declaration based on an oath or declaration being stale.....or **where the date of execution has been omitted.**

Therefore, it is not necessary to provide a new declaration.

3. Drawings

It is asserted that some parts in Figures 8-15 (gel pictures) are hardly observed. In response, Applicants herewith submit new Figures 8-15.

4. Specification

The abstract of the disclosure is objected to because the abstract in this instant applicant has more than 150 words. Correction is required. In response, Applicants herewith submit an amended abstract.

Additionally, the disclosure has been objected to. It is specifically asserted that the disclosure contains the following informalities:

(1) Since U.S. case 10/260,031 is now abandoned, applicant is required to update this information in the first sentence of the specification; (2) U.S. case 09/260,031 in the first sentence of the specification is not applicant's case and is a wrong case, please delete; (3) Figures 5, 6, and 18 contain nucleotide sequences having more than 10 nucleotides. However, there are no SEQ ID Nos in Figures 5, 6, and 18 and there are no SEQ ID Nos for these nucleotide sequences in the BRIEF DESCRIPTION OF THE DRAWINGS of the specification related to Figures 5, 6, and 18; (4) U.S. case 07/968,706 in page 14 of the specification now is US Patent No. 5,288,609, applicant is required to update this information; (5) U.S. case 07/499,938 in page 18 of the specification now is abandoned, applicant is required to update this information; (6) U.S. case 07/633,730 in page 35 of the specification now is abandoned, applicant is required to update this information; and (7) there are a nucleotide sequence having more than 10 nucleotides in pages 61 of the specification, there is no SEQ ID No for this nucleotide sequence in pages 61 of the specification.

In response, Applicants first notes that application serial no. 10/260,031 has been revived. Applicants submit herewith as Exhibit 1, a copy of the Decision from the Office of Petitions from the US Patent and Trademark Office granting the petition to revive application serial no. 10/260,031. Therefore, application serial no. 10/260,031 is currently pending.

Second, Applicants have corrected to the first paragraph of the specification to indicate that application serial no. 10/260,031 is a continuation of U.S. patent Application Serial No. 09/302,817 filed on February 3, 1998, now abandoned and that application serial No. 09/302,817 is a divisional of Serial No. 08/182,621, filed on January 13, 1994, also abandoned. Applicants additionally are concurrently submitting a petition to claim benefit under 35 USC 120, 121, or 365(c) of a prior copending nonprovisional application or international application designating the United States of America (37 C.F.R. 1.78(a)).

Furthermore, the specification has been amended as follows. The "Brief Description of Figures" and pages 43, 61 and 62 have been amended to indicate SEQ ID NOs. Pages 14, 18 and 35 have been amended to update the status of application serial nos. 07/968,706, 07/499,938 and 07/633,730 respectively. Specifically, 07/968,706 has issued as US Patent No. 5,288,609. Application serial no. 07/499, 938 was actually abandoned in favor of application serial no. 08/480,000, which issued as US Patent No. 5,958,681. Application serial no. 07/633,730 was actually abandoned in favor of application serial number 08/378,118, which issued as US Patent No. 5,989,809.

Additionally, the status of other pending applications on pages 17, 35 and 36 have been amended to update the status of other US applications cited. Specifically, as noted above, application serial no. 07/499, 938 (see page 17) was actually abandoned in favor of application serial no. 08/480,000, which issued as US Patent No. 5,958,681. EP 435150 actually corresponds to US application no. 07/459,030; therefore, page 35 has been amended accordingly. As noted above US application no. 07/968,706 has issued as US Patent No. 5,788,609.

5. Claim Objections

Claims 91, 110, and 119 are objected to. It is asserted that "present" in the preamble of the claims should be "presents". In response, claims 91, 110 and 119 have been amended to recite that the "construct, which when **introduced** into cell..".

Therefore, the objection has been overcome and should be withdrawn.

6. Claim Rejections -35 USC 112 (New matter)

Claim 122 has been rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. It is asserted that newly added claim 122 requires that said primer comprises tRNA. However, in the Examiner's view, the specification fails to define or provide any disclosure to support such claim recitation.

Applicants respectfully traverses the rejection. However, in order to advance prosecution, claim 122 has been amended to recite that the primer is RNA. Amended claim 122 is supported by the specification at the bottom of page 35 where it is specifically stated

In another embodiment, the protein in the conjugate comprises DNA polymerase or reverse transcriptase and the nucleic acid construct contains at least one sequence complementary to an RNA molecule.

In view of the above arguments and amendment of claim 122, Applicants assert that the rejection of claim 122 under 35 USC 112, first paragraph (new matter) has been overcome. Therefore, Applicants respectfully request that the rejection under 35 USC 112, first paragraph be withdrawn.

7. The Rejections Under 35 USC 102

7.1 The Rejection of Claims 91-105, 107, 108, 110-121, and 123 under 35 U.S.C. 102(b) over Engelhardt *et al.*, (US 2001/0000077 AI, published on March 29, 2001)

It was asserted in the Office Action that since US application nos 08/182,621 and 09/302,817 were abandoned on July 10, 1997 and December 4, 2001 respectively and US application nos. 08/182,621 and 09/302,817 were not co-pending with application no. 10/260,031 and this instant case, the priority date was in the Examiner's view June 6, 2003.

Applicants respectfully traverse the rejection. As noted above, the priority date of the instant application is actually January 13, 1994. Application serial no. 09/302,817 was actually copending with application serial no. 10/260,031. Although the application was unintentionally abandoned in 2001, a petition to revive was submitted and the

petition was indeed granted. For Examiner's reference, Applicants herewith submit as Exhibit 2 a copy of the Notice from the Office of Petitions of the US Patent and Trademark Office indicating that the petition to revive unintentionally abandoned application serial no. 09/302,817 was granted. Thus application serial nos. 10/260,031 and 09/302,817 were indeed copending. As a result US Appln. No. 2001/0000077 should not be applied as prior art.

7.2 The Rejection of Claims 91-105, 107, 108, 110-121, and 123 under 35 U.S.C. 102(e) over Engelhardt et al., (US 6,986,985 B1, filed on March 3, 1998).

It was asserted in the Office Action that since US application nos. 08/182,621 and 09/302,817 were abandoned on July 10, 1997 and December 4, 2001 respectively and US application nos. 08/182,621 and 09/302,817 were not copending with application no. 10/260,031 and this instant case the priority date of this instant case is filing date of application serial no. 10/260,031, which is June 6, 2003.

Applicants respectfully traverse the rejection. As noted above, the priority date of the instant application is actually January 13, 1994. Application serial no. 09/302,817 was actually copending with application serial no. 10/260,031. Although the application was unintentionally abandoned in 2001, a petition to revive was submitted and the petition was indeed granted. For Examiner's reference, Applicants herewith submit as Exhibit 2 a copy of the Notice from the Office of Petitions of the US Patent and Trademark Office indicating that the petition to revive unintentionally abandoned application serial no. 09/302,817 was granted. Thus application serial nos. 10/260,031 and 09/302,817 were indeed copending.

The priority date of US Patent No. 6,986,985 was January 13, 1994 (same date as the instant application); this was the priority date of the instant application. Thus, US Patent No. 6,986,985 should not be applied as prior art.

In view of the above arguments, Applicants assert that the rejections under 35 USC 102 have been overcome. Therefore, Applicants respectfully request that the rejections be withdrawn.

8. The Rejections Under 35 USC103

Claim 122 is rejected under 35 U.S.C. 103(a) as being unpatentable over Engelhardt *et al.*, (1998 or 2001) as applied to claims 91-105, 107, 108, 110-121, and 123 above, and further in view of Toothman (US Patent No. 6,001,572, filed on July 24, 1997 and published on December 14, 1999).

Applicants traverse the rejection. It is Applicants position that neither of these references should be applied as prior art. As noted above, the priority date of the instant application is January 13, 1994 (same date as instant application). The priority date of Engelhardt 1998 is also January 13, 1994; the priority date of Engelhardt 2001 is November 30, 2000(after priority date of instant application) and the priority date of Toothman is July 26, 1996 (after priority date of instant application). Thus, the rejection under 35 USC 103 should be withdrawn.

9. Double Patenting

Claims 91-105, 107, 108, 110-121, and 123 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-90 of copending Application No. 09/727,349. Applicants, in response respectfully traverse the rejection. This is because both the instant application and 09/727,349 claim priority to the same application, application serial no. 08/182,621. Thus neither would be prior art against the other.

Claims 91-105, 107, 108, 110-121, and 123 have been rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 6,986,985 B1. As noted in the previous section, US Patent NO. 6,986,985 should not be as prior art since this patent and the instant application share the same priority date, January 13, 1994.

In view of the above arguments, the obviousness-type double patenting rejections have been overcome. Therefore, Applicants respectfully request that the obviousness-type double patenting rejection be withdrawn.

10. Conclusion

In view of the foregoing, Applicants assert that the claims are now in condition for allowance. Early action to that end is respectfully requested. The Examiner is invited to contact the undersigned at (914) 712-0093 if she has any questions.

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Respectfully submitted,

Cheryl H. Agris

Cheryl H. Agris, Reg. No. 34,086

ENZO LIFE SCIENCES, INC.
c/o ENZO BIOCHEM, INC.
527 Madison Avenue, 9th Floor
New York, New York 10022